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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/866,541	05/29/2001	Tsunekazu Ishihara	3917-4	4238

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EXAMINER
COBURN, CORBETT B

ART UNIT	PAPER NUMBER
3714	

DATE MAILED: 04/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 07-01)

Office Action Summary	Application No.	Applicant(s)
	09/866,541	ISHIHARA ET AL.
	Examiner	Art Unit
	Corbett B. Coburn	3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-72* is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-72* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *29 May 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

   If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☒ All b)☐ Some * c)☐ None of:

   1.☒ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____ .

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

14)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

   a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4)☐ Interview Summary (PTO-413) Paper No(s). _____ .
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 103

1.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2.   Claim 1, 11-13, 15, 16, 21, 23-25, 28, 30-32, 37, 38, 44, 46-48, 53, 54, 63, 65, 66, 69-72

are rejected under 35 U.S.C. 103(a) as being unpatentable over Hara (US Patent Number

5,212,368) in view of Eskildsen (US Patent Number 5,962,839).

Claims 1, 13, 25, 28, 31, 32, 44, 47, 48, 54, 63, 65, 66: Hara teaches a game system

having a plurality of cards. (Abstract) The cards visually portray a figure and include

recorded data for use in a card game. (Col 2, 58-61) There is a game information storage

medium (7a-h) storing a game program relating to game card figures. There is a

processing system (2) for removably receiving therein the game information storage

medium. (Fig 3) The game machine executes an image display game program that is

stored in one memory section. (Col 2, 46-49) The cards store, for each character

depicted, identification data and characteristic data relating to a characteristic of an

associated character (Col 2, 58-61). The game system has a game piece reader (3) for

reading the identification and characteristic data from the card. The processing system

processes the supplied identification and characteristic data from one or more game cards

(a first and second card) in accordance with the game program stored in a second game

program memory section. (Figs 4a & b and 5) It is necessary to read the game cards in order to play the game.

While the processing system may be said to process the characteristic data to apply a change to the original content of the game program stored in the game information storage medium – the processing system updates the variables based on the information read from the cards -- Examiner believes that the claim is directed toward changing program steps. This is not taught by Hara.

Eskildsen teaches a game device that reads a barcode to change the steps taken by the program. (Abstract) Each of the barcodes (corresponding to a single card) represents a program instruction that is executed by the game machine. This allows the user to interactively program the device, thus increasing the flexibility of the game. It would have been obvious to one of ordinary skill in the art at the time of the invention to have the processing system process the characteristic data to apply a change to the original content of the game program stored in the game information storage medium in order to allow the player to interactively program the device, thus increasing the flexibility of the game.

Claims 11, 12, 16, 23, 24, 37, 38: Hara teaches that the card data may be recorded on non-volatile memory (i.e., a magnetic medium) and read therefrom via a magnetic reader. (Col 8, 8-11) In this embodiment, the characteristic data includes ability data recognizably printed on the game card and hidden data not visibly printed on the game card. The picture with identifying information is recognizably printed on the game card while the data stored on the magnetic medium is not visibly printed.

Claim 15: Hara teaches that the characteristic data includes ability data related to the character and the processing system generates a display state of the character in the game based on the ability data read by the external information reading circuit. (Col 2, 46-65)

Claim 21: Hara teaches an identification code (barcode) on the card. (Abstract) This card identifies the visually portrayed character. (Col 2, 58-61) The data stored on the card is, in and of itself, "data for determining the amount of data recorded".

Claims 30, 46, 53: Hara, Fig 1 shows a hand-held device including a display (4).

Claim 69, 72: Hara teaches determining whether a sufficient number of cards have been read to execute the game. (Figs 4a & b and 5) In order to make this determination, the game must base the execution of the game on total amount data. This data is derived from information read from the cards – i.e., the number and type of cards read.

Claims 70, 71: Eskildsen teaches that the barcodes may be read in any order desired by the player. Thus the order may be rearranged.

3.   Claim 7, 9, 18, 27, 33, 35, 49, 55, 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hara & Eskildsen as applied to claim 1, 16, 25, 28, 44 or 54 above, and further in view of Garfield (US Patent Number 5,662,332).

Claims 7, 33, 49, 55: Hara and Eskildsen teach a game machine using cards to play a game associated with a game program. Hara teaches a card collecting game, but does not explicitly teach a trading card game with characters of differing rarity values. Garfield teaches a trading card game including a figure of a character differing in rarity value. (Col 7, 56-58) Garfield teaches having cards of differing rarity values increases the value of the game components (rare cards) and encourages players to trade and collect game

cards. (Col 7, 12-20) It would have been obvious to one of ordinary skill in the art at the

time of the invention to have modified Hara's card game by including trading cards of

differing in rarity value as suggested by Garfield in order to increase the value of the

game components (rare cards) and encourages players to trade and collect game cards.

Claims 9, 35: Hara teaches that the processing system displays the card data read by the

external reading circuitry. (Col 2, 46-49) Garfield teaches including text on the card

explaining an individual feature of the character. (Fig 1B)

Claims 18, 60: Hara teaches storing data on the card that affects the game but does not

teach storing additional data that includes a mini-game program that may be added to the

game based on the game program stored in the game information medium. Garfield

teaches storing additional data including mini-game data for playing a game based on the

game programs stored in the game information storage medium (i.e., duels between

wizards (Col 7, 43-45), monster attacks (Col 4, 21-26), etc.). These mini-games add

interest to the game. It would have been obvious to one of ordinary skill in the art at the

time of the invention to have included mini-game information for playing a game based

on the game programs stored in the game information storage medium in order to add

interest to the game.

Eskildsen teaches a game device that a player can reprogram using barcodes.

This is equivalent to adding a mini-game program to the game based on the game

program stored in the game information medium. Use of barcodes to enter program

information would automate the process of playing the mini-games described in Garfield.

It would have been obvious to one of ordinary skill in the art to stored additional data on

the card that includes a mini-game program that may be added to the game based on the

game program stored in the game information medium in order to automate the process

of playing the mini-games described in Garfield.

Claim 27: Hara teaches cards that store a plurality of kinds of characteristic data (i.e.,

power, offensive & defensive data, Col 8, 36-40) on an identification-code -by-

identification-code basis – i.e., each is recorded on a barcode. Hara has a computer (Fig

3) with semiconductor solid-state memory for storing characteristic data. The computer

is in a case (Fig 1) and is integrally formed with the card reader.

4.   Claims 10 22, 36, 51, 64, 66 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Hara & Eskildsen as applied to claim 1, 16, 28 above, and further in view of Domiteaux

(US Patent Number 5,959,281).

Claims 10, 22, 36, 51, 64, 66: Hara teaches a card reader (3) is an optical reader for

optically reading the identification and characteristic data corresponding to the character

visually depicted on the card. (Col 2, 58-61) Hara teaches a game card that records the

identification and characteristic data as barcodes or some other optical medium (Col 8, 8-

11) but does not explicitly teach a two-dimensional array of dots. Domiteaux teaches

encoding character data as a two-dimensional array of dots (54). Domiteaux teaches that

a two-dimensional array of dots is equivalent of a barcode (Col 6, 32-34). The particular

method of encoding the data used is a matter of design choice, wherein no stated problem

is solved, or unexpected result obtained, by using the specific method of encoding the

data claimed versus the indicia taught by the prior art. It would have been obvious to one

of ordinary skill in the art at the time of the invention to have encoded the character data

as a two-dimensional array of dots in order to meet the needs of the card designer.

5.   Claims 8, 14, 19, 34, 50, 56 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Hara & Eskildsen as applied to claims 1, 13, 16, 28, 44, 51 above, and further in view of

Doederlien et al. (US Patent Number 5,855,001).

> **Claims 8, 14, 19, 34, 50, 56:** Hara and Eskildsen teach the invention substantially as
>
> claimed. Hara teaches providing appropriate sound data (Col 2, 51-54) via barcodes,
>
> which, by their size indicate the amount of data stored, but does not specifically teach
>
> that the characteristic data stored on the card includes sound data nor does Hara
>
> specifically teach generating sounds based on this data. Doederlien, another card
>
> reader/trading card game, teaches storing sound data on the card and generating sounds
>
> based on that data. (Col 1, 63-67) Doederlien teaches that trading cards that contain
>
> sound data "provide more information and value than that available from passive sports
>
> cards." (Col 1, 25-28) This in turn increases the demand for the cards. It would have
>
> been obvious to one of ordinary skill in the art at the time of the invention to have stored
>
> sound data on the card and generated sounds based on that data in order to provide more
>
> information and value than that available from passive cards, thus increasing demand for
>
> the cards.

6.   Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hara & Eskildsen

as applied to claim 16 above, and further in view of Garfield and Doederlien et al.

> **Claim 20:** Hara and Eskildsen teach the invention substantially as claimed but do not
>
> specifically teach text data explaining a feature of the character. Garfield teaches text

data (16) explaining a feature of a character. Providing text data explaining a feature of a

character makes the game easier to play. It would have been obvious to one of ordinary

skill in the art at the time of the invention to have provided text data explaining a feature

of a character in order to make the game easier to play.

Hara and Eskildsen teach the invention substantially as claimed. Hara teaches

providing appropriate sound data (Col 2, 51-54), but does not specifically teach that the

characteristic data stored on the card includes sound data nor does Hara specifically teach

generating sounds based on this data. Doederlien, another card reader/trading card game,

teaches storing sound data on the card and generating sounds based on that data. (Col 1,

63-67) Doederlien teaches that trading cards that contain sound data "provide more

information and value than that available from passive sports cards." (Col 1, 25-28) This

in turn increases the demand for the cards. It would have been obvious to one of ordinary

skill in the art at the time of the invention to have stored sound data on the card and

generated sounds based on that data in order to provide more information and value than

that available from passive cards, thus increasing demand for the cards.

7.   Claims 26, 29, 39-43, 45, 57-59, 68 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Hara and Eskildsen as applied to claims 25, 28, 44 above, and further in view

of Bronstein (US Patent Number 4,386,773).

Claims 26, 41, 43, 68: Hara teaches a groove (Fig 1) for receiving at least a portion of

the card and reading the card. Hara does not, however, teach putting the groove and card

reader on a removable memory cartridge. Bronstein teaches a memory cartridge for

containing game program information. These are typically used in home video game

systems to store programs and provide specialized circuitry required for the game. Home

video games are extremely popular. It would have been obvious to one of ordinary skill

in the art at the time of the invention to have mounted the card reader on the removable

cartridge in order to implement Hara's disclosure on a home video game system, thus

taking advantage of the tremendous popularity of these systems. As Bronstein clearly

illustrates (Figs 2 & 3), these cartridges contain a semiconductor memory for storing

programs and a case accommodating the memory.

Claims 29, 45: Hara and Eskildsen teach the invention substantially as claimed but do

not specifically teach a game cartridge including processing circuits. Game cartridges are

extremely well known in the art. Bronstein provides but one example. Game cartridges

are used to prevent software piracy. It would have been obvious to one of ordinary skill

in the art at the time of the invention to have used a game cartridge in order to prevent

software piracy.

Claim 39: Hara and Eskildsen teach the invention substantially as claimed. Hara

teaches program memory (7a-h) for storing a game program involving cards. (Abstract)

Hara teaches a data reader (3) for reading data from at least one card and processing

circuits for processing data read from the card. There is a connector connecting the card

reader to the game machine having a processing system for executing a game program.

(Fig 3) But Hara does not teach a removable memory. Game cartridges are extremely

well known in the art. Bronstein provides but one example. Game cartridges are used to

prevent software piracy. It would have been obvious to one of ordinary skill in the art at

the time of the invention to have used a game cartridge in order to prevent software

piracy.

Claim 40: Bronstein teaches a cartridge with RAM (32).

Claim 42: Hara teaches a game machine that executes an image display game program

that is stored in one memory section. (Col 2, 46-65) The cards store, for each character

depicted, identification data and characteristic data relating to a characteristic of an

associated character. The game system has a game piece reader (3) for reading the

identification and characteristic data from the card. The processing system processes the

supplied identification and characteristic data in accordance with the game program

stored in a second game program memory section. (Figs 4a & b and 5)

Claim 57: Hara teaches a game system having a plurality of cards. (Abstract) The cards

visually portray a figure and include recorded data for use in a card game. (Col 2, 58-61)

There is a game information storage medium (7a-h) storing a game program relating to

game card figures. There is a processing system (2) for removably receiving therein the

game information storage medium. (Fig 3) The game machine executes an image

display game program that is stored in one memory section. (Col 2, 46-49) The cards

store, for each character depicted, identification data and characteristic data relating to a

characteristic of an associated character (Col 2, 58-61). The game system has a game

piece reader (3) for reading the identification and characteristic data from the card. The

processing system processes the supplied identification and characteristic data from one

or more game cards in accordance with the game program stored in a second game

program memory section. (Figs 4a & b and 5) The processing system, when not

supplied with the identification data and characteristic data by the card reader (3)

executes a process on the basis of only the game program stored in memory – the game

program can generate data to play the game when only one player inserts a card and a

second player fails to do so. (Col 3, 29-31) While the processing system may be said to

process the characteristic data to apply a change to the original content of the game

program stored in the game information storage medium – the processing system updates

the variables based on the information read from the cards -- Examiner believes that the

claim is directed toward changing program steps. This is not taught by Hara.

Eskildsen teaches a game device that reads a barcode to change the steps taken by

the program. (Abstract) This allows the user to interactively program the device, thus

increasing the flexibility of the game. It would have been obvious to one of ordinary skill

in the art at the time of the invention to have the processing system process the

characteristic data to apply a change to the original content of the game program stored in

the game information storage medium in order to allow the player to interactively

program the device, thus increasing the flexibility of the game.

Hara also fails to teach putting the game program in a removable storage medium.

Bronstein teaches a memory cartridge for containing game program information. These

are typically used in home video game systems to store programs and provide specialized

circuitry required for the game. Home video games are extremely popular. It would

have been obvious to one of ordinary skill in the art at the time of the invention to have

mounted the card reader on the removable cartridge in order to implement Hara's

disclosure on a home video game system, thus taking advantage of the tremendous

popularity of these systems. As Bronstein clearly illustrates (Figs 2 & 3), these cartridges

contain a semiconductor memory for storing programs and a case accommodating the

memory.

Claims 58 & 59: Claims 58 & 59 contain the limitations of claim 57 (which see) plus a

limitation that state that the first storage section contains a program that checks the card

reader to see if data is available and writes the data to the second memory area. Hara

teaches this. (Figs 4a & b and 5)

8.   Claims 61 & 62 rejected under 35 U.S.C. 103(a) as being unpatentable over Hara in view

of Yamada (US Patent Number 6,398,651).

Claim 61: As discussed in detail above, Hara teaches the invention substantially as

claimed, but does not teach the game card being machine-readably recorded with image

data for displaying the image of a character on the display screen. It is well within the

capability of Hara to store such data. Yamada teaches storing such information on cards

and displaying the image data read from the card on the screen. This adds to the visual

interest of the card game. It would have been obvious to one of ordinary skill in the art at

the time of the invention to have machine-readably stored image information on cards

and displaying the image data read from the card on the screen in order to add to the

visual interest of the card game.

Claim 62: Hara teaches a game card that records the identification and characteristic

data as barcodes or some other optical medium (Col 8, 8-11) but does not explicitly teach

an array of dots distributed within blocks. The particular method of encoding the data

used is a matter of design choice, wherein no stated problem is solved, or unexpected

result obtained, by using the specific method of encoding the data claimed versus the

indicia taught by the prior art.

9.   Applicant's arguments with respect to claims 1-56 have been considered but are moot in

view of the new ground(s) of rejection.

Conclusion

10.   Applicant's amendment necessitated the new ground(s) of rejection presented in this

Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this

final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Corbett B. Coburn whose telephone number is (703) 305-3319.

The examiner can normally be reached on 8-5:30, Monday-Friday, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

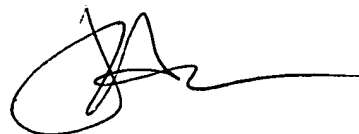supervisor, Tom Hughes can be reached on (703) 308-1806. The fax phone numbers for the

organization where this application or proceeding is assigned are (703) 872-9302 for regular

communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding

should be directed to the receptionist whose telephone number is (703) 308-1148.

cbc

April 22, 2003

JESSICA HARRISON
PRIMARY EXAMINER